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OFFICE OF PETITIONS

In re Application of :
Hansen et al. :
Application No. 10/776934 : DECISION ON APPLICATION
Filing or 371(c) Date: 02/10/2004 : FOR PATENT TERM ADJUSTMENT
Attorney Docket Number: :
366929-018US (396515) :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(b), filed June 29, 2009.

Applicant submits that the correct patent term adjustment to be indicated on the patent is 864 days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction (1) based upon an assertion that the Office miscalculated a four month adjustment incurred by the Office, and (2) on the basis that the Office will take in excess of three years to issue this patent. Applicants also disagree with the Office's failure to calculate any delay with respect to an Amendment filed by applicants pursuant to 37 CFR 1.312.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's miscalculation of a four (4) month delay incurred by the Office in its non-final Office action, mailed April 17, 2007, pursuant to 37 CFR 1.702(a)(2) is hereby **DISMISSED**.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

BACKGROUND

On April 17, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

**ON PETITION UNDER 37 CFR 1.705(b)
REQUESTING RECONSIDERATION OF THE PERIOD OF ADJUSTMENT
PURSUANT TO 37 CFR 1.702(a)(2)**

On June 29, 2009, applicants timely submitted the present request for review of patent term adjustment¹. Applicants do not dispute the adjustment to date of 101 days. Further, applicants do not dispute the reductions to date of 92 days; 158 days; 86 days; 87 days and 50 days attributed to applicant pursuant to 37 CFR §§ 1.704(b) and 1.704(c)(7). Applicants, however, assert that an entitlement to a period of adjustment of 322 days of Office delay in failing to mail an action under 35 U.S.C. 132 not later than four months after a reply under 35 U.S.C. 111 was filed.

In this regard, applicants provide that on January 20, 2006, applicants filed a reply under 35 U.S.C. 111, including a reply to a Restriction Requirement, however, the Office failed to respond to applicants reply until April 17, 2007, or 322 days after the date that is four months after the reply of January 20, 2006 was filed.

Applicants arguments have been carefully considered. A review of the application file history reveals that the non-final Office action mailed April 17, 2007, addressed claims amended by applicants with the filing of the March 15, 2007 amendment. As such, the non-final Office action was timely pursuant to 37 CFR 1.702(a)(2)².

**ON PETITION UNDER 37 CFR 1.705(b)
REQUESTING RECONSIDERATION OF THE PERIOD OF ADJUSTMENT
PURSUANT TO 37 CFR §§ 1.702(c)(10), 37 CFR 1.702(b) and 1.703(b)**

Applicants disagree with the Office's failure to calculate any delay with respect to the Amendment filed by Applicants pursuant to 37 CFR 1.312. Applicants also assert an entitlement to a period of patent term adjustment pursuant to 37 CFR §§ 1.702(b) and 1.703(b) due to examination delay equal to the number of days in the period beginning on the day after the date that is three years after February 10, 2004, when the above-referenced application was filed under 35 U.S.C. §111(a)(i.e. February 11, 2007), and ending on the date the patent is issued, not

¹ Office records show that the Issue Fee payment was received in the Office on June 29, 2009.

² The response filed January 20, 2006, was not fully responsive to the Restriction Requirement, mailed July 20, 2005. Applicants were so notified in a Notice of Non-Compliant Amendment, mailed April 20, 2006. Applicants filed a "Second Response to Restriction Requirement," on June 27, 2006, which was also non-compliant. The Office mailed a Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice"), on September 19, 2006. Applicants reply to the Notice, filed March 15, 2007, amended claims 153, 160-165 and 167-168, in compliance with the Notice mailed September 19, 2006. The Office action mailed April 17, 2007, addressed, inter alia, claims 153, 160-165 and 167-168, which were amended in the March 15, 2007 amendment.

Moreover, applicants agree with the Office's calculation of delays pursuant to 37 CFR 1.704(c)(7), in connection with the filing of the responses on June 27, 2006; of 158 days and 86 days in connection with the filing of the amendments on June 27, 2006 and March 15, 2007 respectively. Application for PTA at p.4. 37 CFR 1.704(c)(7) reduces the period of reduction for the submission of a reply having an omission, which ends on the date that the reply or other paper correcting the omission was filed.

including several categories of exceptions stated in 35 U.S.C. § [1]54(b)(1)(B)(i)-(iii) (“3 Year Delay”).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office’s failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). This is true even where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee³.

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is zero (0) days (adjustments totaling 101 days less reductions totaling 473 days).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

³ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Supervisor
Office of Petitions